

This Opinion is Not a
Precedent of the TTAB

Mailed: August 22, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Randy Wayne White
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Serial No. 90758882
—

J. Todd Timmerman of Shumaker Loop & Kendrick LLP,
for Randy Wayne White.

Charles Miller, Trademark Examining Attorney, Law Office 112,
Matthew Cuccias, Managing Attorney.¹
—

Before Taylor, Shaw and Goodman
Administrative Trademark Judges.

Opinion by Shaw, Administrative Trademark Judge:

I. Background

Randy Wayne White (“Applicant”) seeks registration on the Principal Register of the wording YUCATAN SHRIMP (in standard characters) for goods identified as

¹ This application was previously assigned to Trademark Examining Attorney Sarah Valenti during examination and was reassigned to Charles Miller for preparation of the brief on appeal.

Citations to the prosecution file refer to the .pdf version of the USPTO’s Trademark Status & Document Retrieval (“TSDR”) system and identify documents by title and date. References to the briefs and other materials in the appeal record refer to the Board’s TTABVue online docketing system.

“prepared food, namely, shrimp, not live,” in International Class 29.² Applicant has voluntarily disclaimed the term SHRIMP.

The Trademark Examining Attorney has refused registration of Applicant’s proposed mark under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), on the ground that the wording YUCATAN SHRIMP is merely descriptive of the identified goods. When the refusal was made final, Applicant appealed. The case is fully briefed. We affirm the refusal to register.

II. Mere Descriptiveness

Section 2(e)(1) of the Trademark Act prohibits registration on the Principal Register of “a mark which, (1) when used on or in connection with the goods of the applicant is merely descriptive ... of them,” unless the mark has been shown to have acquired distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f). A mark is “merely descriptive” within the meaning of Section 2(e)(1) “if it immediately conveys information concerning a feature, quality, or characteristic of the goods or services for which registration is sought.” *In re N.C. Lottery*, 866 F.3d 1363, 123 USPQ2d 1707, 1709 (Fed. Cir. 2017) (citing *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007)). “A mark need not immediately convey an idea of each and every specific feature of the goods in order to be considered merely descriptive; it is enough if it describes one significant attribute, function or property

² Application Serial No. 90758882 was filed on June 7, 2021 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), alleging a date of first use anywhere and in commerce of 2005.

of the goods.” *In re Fat Boys Water Sports LLC*, 118 USPQ2d 1511, 1513 (TTAB 2016) (citing *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1010 (Fed. Cir. 1987)).

We “must consider the mark as a whole and do so in the context of the goods . . . at issue.” *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012). This applies to compound marks as well:

In considering a mark as a whole, the Board may weigh the individual components of the mark to determine the overall impression or the descriptiveness of the mark and its various components. . . . [I]f . . . two portions individually are merely descriptive of an aspect of appellant’s goods, the PTO must also determine whether the mark as a whole, i.e., the combination of the individual parts, conveys any distinctive source-identifying impression contrary to the descriptiveness of the individual parts.

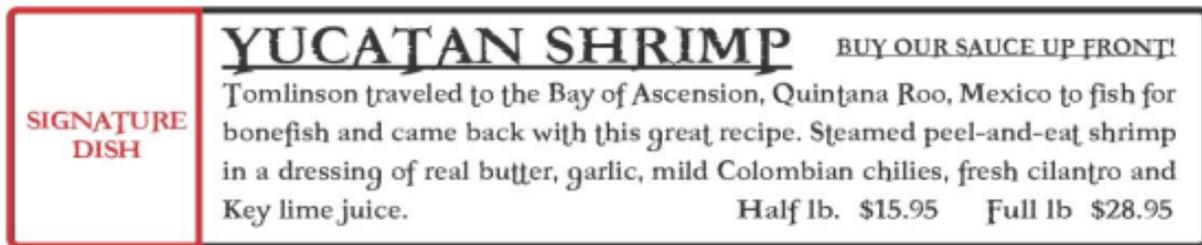
In re Oppedahl & Larson LLP, 373 F.3d 1171, 71 USPQ2d 1370, 1372 (Fed. Cir. 2004) If each component retains its merely descriptive significance in relation to the goods or services, then the mark as a whole is merely descriptive. *Id.* at 1374; *In re Mecca Grade Growers, LLC*, 125 USPQ2d 1950, 1955 (TTAB 2018).

We find it “useful to consider the public’s understanding of the individual words” as part of assessing the proposed mark in its entirety. *Princeton Vanguard, LLC v. Frito-Lay North Am., Inc.*, 786 F.3d 960, 114 USPQ2d 1827, 1832-33 (Fed. Cir. 2015). Evidence of the public’s understanding of a term may be obtained from “any competent source, such as consumer surveys, dictionaries, newspapers and other publications.” *Princeton Vanguard*, 114 USPQ2d at 1830 (quoting *In re Northland Aluminum Prods., Inc.*, 777 F.2d 1556, 227 USPQ 961, 963 (Fed. Cir. 1985)). “In assessing the primary significance of Applicant’s proposed mark to the relevant

public, we also may consider Applicant’s use thereof.” *In re Consumer Prot. Firm PLLC*, 2021 USPQ2d 238, at *8 (TTAB 2021) (citing *In re Gould Paper Corp.*, 834 F.2d 1017, 5 USPQ2d 1110, 1112 (Fed. Cir. 1987)).

It is the examining attorney’s burden to show that a term is merely descriptive of an applicant’s goods or services. *In re Gyulay*, 3 USPQ2d at 1010. Once a prima facie case is established, the burden of rebuttal shifts to Applicant. *Id.*

As noted above, Applicant’s goods are “prepared food, namely, shrimp, not live.” Applicant’s specimen, comprising a two-page menu from “Doc Ford’s Rum Bar & Grille,” includes the following description of Applicant’s YUCATAN SHRIMP dish:³



According to page two of the menu, “Doc Ford,” the restaurant’s namesake, and “Tomlinson,” are fictional characters found in Applicant’s novel, *Sanibel Flats*, and in subsequent novels.⁴

The Examining Attorney argues that YUCATAN SHRIMP is merely descriptive because “it immediately and directly describes to potential consumers the characteristic of the goods, namely, that they are small crustaceans cooked in the style of the Yucatan Peninsula in the Gulf Coast of Mexico. Indeed, the record

³ Application specimen, p. 1.

⁴ *Id.* at 2.

evidence demonstrates that Yucatan Shrimp is a well-recognized dish and restaurant menu item.”⁵

In support of the refusal, the Examining Attorney introduced a number of third-party webpage excerpts showing that third-party restaurants as well as cooking websites use the term YUCATAN SHRIMP to refer to Mexican-inspired shrimp dishes. The following examples of YUCATAN SHRIMP dishes from third-party restaurants are most relevant:

- Yucatan Grill menu: “Yucatan Grilled Shrimp -- Jumbo shrimp marinated in Recado Rojo sauce (a blend of cumin, cinnamon, oregano, garlic and citrus juice) and grilled.”⁶
- Mulligans Restaurant and Lounge menu: “YUCATAN SHRIMP TACOS -- tempura shrimp, chorizo, pineapple salsa, pickled red onion, queso fresco, chipotle aioli & avocado crema.”⁷
- Mexico Restaurant menu: “YUCATÁN SHRIMP -- Shrimp grilled with bell peppers, onions, zucchini and squash in our unique Yucatan sauce. Served over a bed of Mexican white rice and with fresh pico de gallo salad and sour cream.”⁸
- Yucatan Beach Stand Restaurant menu: “Yucatan Shrimp Tacos -- Steamed shrimp sautéed in our house Yucatan sauce, with cabbage, tomato and cilantro.”⁹
- Talking Stick Restaurant menu: “YUCATÁN SHRIMP -- chipotle-marinated shrimp, pico, cabbage, jalapeño crema.”¹⁰

⁵ Examining Attorney’s Br., p. 2, 6 TTABVUE 2.

⁶ May 16, 2022 Final Office Action, TSDR p. 42.

⁷ *Id.* at 46.

⁸ *Id.* at 47.

⁹ *Id.* at 49.

¹⁰ *Id.* at 51.

- Tower 7 Restaurant menu: “YUCATAN SHRIMP -- Grilled Achiote Shrimp & Pineapple, Jalapeño, Avocado, Green Onion, Monterey Jack & Chipotle Aioli.”¹¹
- Encore Bistro & Bar menu: “Yucatan Shrimp” comprised of four jumbo shrimp, garlic butter, sambal, jalapeño, lime, and cilantro.¹²
- Catrinas Modern Mexican Restaurant menu: “SPICY YUCATAN SHRIMP -- jumbo shrimp, garlic butter, squash, mushroom, Indonesian sambal chili paste, Mexican rice, lettuce, pico de gallo, crema, guacamole.”¹³
- Point 57 Kitchen and Cocktails restaurant menu: “YUCATAN SHRIMP -- Sauteed shrimp, garlic, Sambal chili, butter, cilantro, fresh lime, yellow rice, sauteed mixed vegetables.”¹⁴
- Tomatillos Restaurant menu: “Yucatan Shrimp -- Gulf shrimp tossed in a Garlic, Butter, Lime & Red Chili Paste Sauce.”¹⁵
- Red Lobster Restaurant menu: “Yucatan Shrimp -- Two jumbo shrimp roasted in chili-lime butter with caramelized pineapple and topped with fresh jalapenos.”¹⁶
- Costal Flats Restaurant menu: “Yucatan Shrimp Cocktail . . . gulf shrimp, mango, jicama and avocado in a traditional tomato, orange and lime sauce.”¹⁷

The following examples of YUCATAN SHRIMP recipes from cooking websites are most relevant:

- Recipe for “Spicy Baked Yucatan shrimp” from a cookbook titled *Emily’s Fresh Kitchen*, reviewed by the news site Kare 11. The recipe includes shrimp, garlic, chili garlic sauce, lime juice, and cilantro.¹⁸

¹¹ *Id.* at 57.

¹² *Id.* at 62.

¹³ *Id.* at 68.

¹⁴ *Id.* at 71.

¹⁵ February 24, 2022 Office Action, TSDR p. 40.

¹⁶ *Id.* at 50.

¹⁷ *Id.* at 56.

¹⁸ May 16, 2022 Final Office Action, TSDR pp. 7-9.

- Recipe for the “The BEST Yucatan Shrimp” by Shock Munch.com. The recipe includes shrimp, garlic, jalapenos, lime juice, chili flakes, and cilantro.¹⁹
- Recipe for “Grilled Yucatán Shrimp” by *Food & Wine*. The recipe includes shrimp, garlic, orange juice, chile powder, and cilantro.²⁰
- Recipe for “YUCATAN SHRIMP” by Lawry’s® from McCormick.com. The recipe includes shrimp, Lawry’s® Baja Marinade, and cilantro.²¹
- Recipe for “Yucatan Shrimp” by Operation in Touch. The recipe includes shrimp, garlic, chipotle pepper in adobo sauce, and cilantro.²²
- Recipe for “Yucatan Shrimp” by Parade. The recipe includes shrimp, habanero chile, lime juice, and cilantro.²³
- Recipe for “Yucatan Grilled Shrimp” by Creole Contessa. The recipe includes shrimp, limes, and habanero and jalapeno peppers.²⁴
- Recipe for “Yucatan Style Shrimp Cocktail” by The Constant Epicurean. The recipe includes shrimp, hot sauce, lemon juice, and cilantro.²⁵

The Examining Attorney also introduced a dictionary definition of the term “shrimp” and a Wikipedia entry for the Mexican State of Quintana Roo which encompasses a portion of the Yucatan Peninsula in Central America.²⁶

We find that the Examining Attorney’s evidence demonstrates that YUCATAN SHRIMP, when considered as a whole, is merely descriptive of the goods in the application because it identifies a characteristic of the goods, namely, a Mexican-

¹⁹ *Id.* at 15-22.

²⁰ February 24, 2022 Office Action, TSDR pp. 6-7.

²¹ *Id.* at 11-12.

²² *Id.* at 18.

²³ *Id.* at 20-22.

²⁴ *Id.* at 30-32.

²⁵ *Id.* at 62-66.

²⁶ May 16, 2022 Final Office Action, TSDR pp. 78-84.

inspired shrimp dish. That is, the foregoing third-party usage establishes that YUCATAN SHRIMP is recognized as a food dish that typically uses shrimp, and is prepared using Mexican-inspired ingredients, particularly peppers or others hot sauce, lime or other citrus juice, and cilantro. Notably, two of the third-party restaurants listed above—the Yucatan Grill and the Yucatan Beach Stand—offer several “Yucatan” themed dishes.

Applicant’s usage of YUCATAN SHRIMP on its menus further supports this finding. Applicant’s menu states that the dish was brought back from Quintana Roo, Mexico on the Yucatan peninsula. Although this statement is fictional, it nevertheless suggests that the restaurant-going public would perceive YUCATAN SHRIMP to be a recipe from the Yucatan region or Mexico. This is particularly likely given that Applicant’s YUCATAN SHRIMP dish is made from shrimp, chilies, cilantro and lime juice which are the same basic ingredients used in the Mexican-inspired third-party dishes discussed above.

We also note that Applicant’s menu uses the term YUCATAN SHRIMP in the same size, typeface, and prominence as other descriptive or generic menu items such as FLATBREAD, SALADS, SOUPS, SANDWICHES, and SEAFOOD TACOS.²⁷ This reduces the likelihood that consumers would view YUCATAN SHRIMP as a trademark for Applicant’s dish. The fact that Applicant’s menu characterizes its YUCATAN SHRIMP as a “signature dish” does not rebut the finding that the wording

²⁷ Application specimen, p. 2.

is merely descriptive, particularly in the absence of evidence that consumers would understand this characterization to impart trademark significance.

Applicant advances several arguments why the refusal is wrong, but we find none convincing. Applicant first argues that the Examining Attorney's evidence fails to establish that YUCATAN SHRIMP is merely descriptive because the evidence does not establish that there is any style of cooking that originates from the Yucatan region of Mexico. According to Applicant:

[T]he Examiner's evidence shows so many different styles of cooking that it actually appears there is no particular style of cooking that originates in the Yucatan. The term "Yucatan Shrimp" is used for very different dishes – dishes with different ingredients, different methods and styles of cooking, and different presentations. Thus, the YUCATAN SHRIMP mark is arbitrary or suggestive because it does not immediately convey anything in particular about a feature, quality, or characteristic of Applicant's goods.²⁸

We disagree. The evidence establishes that consumers are presented with numerous menus and recipes for YUCATAN SHRIMP identifying a Mexican-inspired prepared shrimp dish. Although there are differences between the various third-party YUCATAN SHRIMP dishes, nearly all of them have the same basic ingredients, namely, shrimp, chili peppers or others hot sauce, lime or other citrus juice, and cilantro.

Applicant argues further that the third-party evidence is unpersuasive because it does not show use of YUCATAN SHRIMP as a trade mark:

²⁸ Applicant's Br., p. 4, 4 TTABVUE 6.

[T]he various “Yucatan Shrimp” recipes referenced by the Examining Attorney do not constitute trademark or service mark use. TMEP §1301.01(a)(i) (“a recipe . . . is not a service”). They are simply titles given to recipes by their authors, likely due to the exotic aura created by the use of the word “Yucatan.” With respect to the restaurants, their motivation to call a dish on their menus “Yucatan Shrimp” is unclear.²⁹

This argument is unavailing. The fact that third parties do not use YUCATAN SHRIMP as a trademark or service mark increases the weight of the evidence in establishing the proposed mark is merely descriptive. In other words, the fact that numerous restaurants and cooking websites treat YUCATAN SHRIMP as the name of a food dish, and not as a mark, suggests that the consuming public also is unlikely to view YUCATAN SHRIMP as a mark.

Applicant next argues that its YUCATAN SHRIMP recipe is uniquely identified as “originating with the Applicant.” For support, relies on a 2010 New York Times article, a recipe accompanying the article, and on public comments on the article.³⁰

According to Applicant:

The article notes from the outset that the recipe includes an Indonesian spice called “sambal” and comes out of Doc Ford’s Sanibel Rum Bar and Grille in Southwest Florida, and elaborates that “however you prepare it, you could eat this meal tonight in Des Moines or Brooklyn, in Paris or

²⁹ *Id.* at 17, 4 TTABVUE 19.

³⁰ During examination, the Examining Attorney objected to the recipe and comments associated with the New York Times article on the ground that the evidence did not “specify the date it was downloaded or accessed.” Final Office Action of May 16, 2022, TSDR 4. This was improper. The evidence was properly introduced by Applicant via an accompanying declaration identifying both the URLs and access dates. *See* April 14, 2022 Response to Office Action, TSDR 9; *Safer, Inc. v. OMS Invs., Inc.*, 94 USPQ2d 1031 (TTAB 2010). The Examining Attorney considered this evidence in his brief. We have considered the evidence as well.

Jakarta, and imagine yourself on a beach staring south, the moment holding perfect as a soap bubble that might never pop.” The dish called “Yucatan Shrimp” is, in the author’s words, “a late-spring meal to evoke deep summer, when the heat lies heavy even at dusk and humidity wraps you like a blanket.” The modifier “Yucatan” conveys nothing geographic about the recipe, but rather conjures thoughts of heat and the tropics, such as the environs of Southwest Florida. A number of highlighted comments that follow the article and recipe mention the “Yucatan Shrimp” dish as originating with Applicant and his associated restaurants, rather than the Yucatan. Not a single one of the 209 comments spanning a period of 4 years after the article identifies (or misidentifies for that matter) “Yucatan Shrimp” as a shrimp dish prepared in the traditional style of the gulf coast region of Mexico. Rather they uniquely identify the recipe as one originating with the Applicant.³¹

This argument is unpersuasive. The fact that a single newspaper article and an accompanying recipe with comments discuss Applicant’s YUCATAN SHRIMP dish does not rebut the Examining far more extensive third-party restaurant and cooking website evidence. Nor is the evidence as compelling as Applicant alleges. Only thirteen or so of the 209 comments associate YUCATAN SHRIMP with Doc Ford’s Bar and Grille. In fact, many of the other comments included modifications to the recipe such as adding sriracha, ginger, olive oil, wine, and scallions.³² This suggests, as discussed above, that consumers understand the term YUCATAN SHRIMP to identify a single dish with basic ingredients, namely, shrimp, chili peppers or others hot sauce, lime or other citrus juice, and cilantro, regardless of what other ingredients

³¹ Applicant’s Br., p. 19, 4 TTABVUE 21.

³² April 14, 2022 Response to Office Action, TSDR 17-51.

may be added. Moreover, the fact that an applicant may be the first and only user of a merely descriptive designation does not justify registration if the only significance conveyed by the term is merely descriptive. *See Fat Boys Water Sports*, 118 USPQ2d at 1514.

In sum, we find the Examining Attorney's has established that the wording YUCATAN SHRIMP is merely descriptive of a prepared shrimp dish, and that Applicant has not rebutted that showing. *In re Gyulay*, 3 USPQ2d at 1010.

Decision: The refusal to register Applicant's proposed mark YUCATAN SHRIMP under Section 2(e)(1) of the Trademark Act is affirmed.